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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,495	07/05/2001	Christopher W. Benjamin	00180.US1/PHRM-0340	2579
34135	7590	01/18/2005	EXAMINER	
COZEN O'CONNOR, P.C. 1900 MARKET STREET PHILADELPHIA, PA 19103-3508			LANDSMAN, ROBERT S	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/899,495

Applicant(s)

BENJAMIN ET AL.

Examiner

Robert Landsman

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 September 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 107-109 and 149-152.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: All claim objections have been overcome

Robert Landsman  
Primary Examiner  
Art Unit: 1647

Continuation of 2. NOTE: Claim 149 is rejected under 35 USC 112, first paragraph, since it contains new matter. Support for the limitation "comprises no more than 471 residues" cannot be found in the specification or claims as originally filed.


New claim 152 is rejected under 35 USC 112, first paragraph, since it contains new matter. While the Application discloses that conservative amino acid substitutions can be made, there is no support for the limitation "at least one."

New claim 152 is rejected under 35 USC 112, first paragraph, as lacking enablement since Applicants have not provided guidance or working examples of how to produce functional 5HT3 receptors by altering, according to the claim, up to and including every original amino acid in the protein (i.e. "at least one conservative amino acid substitution"), nor is it predictable to the artisan.

New claims 149-152 are also rejected under 35 USC 112, first paragraph, for these reasons. The claims do recite that the receptor is human. However, they do not recite a 5HT3-specific limitation, such as the binding of a 5HT-3-specific ligand. Applicants' pertinent argument for claims 107-109 regarding that numerous Examples are disclosed in the specification which could provide enablement for the claimed methods is not persuasive. The standard for enablement is, respectfully, "make and use," not "make and test."

Continuation of 3. Applicant's reply has overcome the following rejection(s): claims 107-109 under 35 USC 112, second paragraph. Applicants have demonstrated support in the specification as originally filed for claim 107 regarding "99% sequence homology." The rejection of claims 108 and 109 has been withdrawn in view of the change in dependency.

Continuation of 5. does NOT place the application in condition for allowance because: claims 107-109 remain rejected under 35 USC 112, first paragraph, regarding lack of enablement and lack of written description for the reasons already of record on pages 4-7 of the Office Action dated 6/14/04. New claims 149-152 are also rejected under 35 USC 112, first paragraph, for these reasons. The claims, which now recite that the receptor is human, do not recite a 5HT3-specific limitation, such as the binding of a 5HT-3-specific ligand. Applicants' argument that numerous Examples are disclosed in the specification which could provide enablement for the claimed methods is not persuasive. The standard for enablement is, respectfully, "make and use," not "make and test."

  
ROBERT LANDSMAN  
PATENT EXAMINER